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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,132	09/22/2003	Mark Pearson	40441-0003	2865
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HELLER EHRMAN LLP 4350 La Jolla Village Drive, 7th Floor San Diego, CA 92122			EXAMINER REYES, REGINALD R	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,132

Applicant(s)

PEARSON, MARK

Examiner

REGINALD REYES

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-651/652)
Paper No(s)/Mail Date 11-19-2004/08-17-2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-69 have been examined.

Claim Objections

2. Claim 7 is objected to because of the following informalities: Claim 7 is missing the claim number that it's depending from. Appropriate correction is required. For examining purposes, examiner will use claim 1.
3. Claim 64 is objected to because of the following informalities: Claim 64 attached the phrase "of claim 16". Examiner suggests removing the phrase. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how points that are awarded to member are considered income. An essential purpose of patent examination is to

fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed-In re Zletz,13 USPQ2d 1320 (Fed. Cir. 1989)

5. Claims 5 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the associated costs with a health savings account that the points have to offset.

6. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the exempt organization is and what it's fulfilling its exempt purpose is.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 3, 5, 7, 12, 13, 16, 18, 20, 23, 24, 25, 28, 32, 38, 39, 41, 43, 45, 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Paasche et al (U.S. 7,359,871).

8. With respect to claims 1, 12, and 25 Paasche teaches a method of selling a health related product or service via the Internet, comprising:

providing a service provider system that includes a web server, the service provider system having members that purchase health related products and services through the service provider system (see for example Paasche column 25 lines 2-30); enrolling applicants in the service provider system as members (see for example Paasche column 2 lines 23-42); receiving a product or service request message for a desired product or service from a member through a customer interface, the product or service request message including a product or service identifier (see for example Paasche column 2 lines 63-67 and column 3 lines 1-16 and Fig 1); transmitting by the service provider system a request for the desired product or service request to a supplier of the desired product or service (see for example Paasche column 9 lines 30-42); and recording within a computer memory points awarded to a member for purchases (i) made by the member through the service provider system (see for example Paasche column 66 lines 26-42 and Fig. 20); (ii) made by members who were referred to the service provider system by the member (see for example Paasche column 29 lines 65-66), and (iii) made by members who were referred to the service provider system by members in (ii) (see for example Paasche column 31 lines 65-67 and column 32 lines 1-4 and Fig. 2).

9. With respect to claims 2, 13 and 38, Paasche teaches the method of claim 1 and 12, respectively, (as described above). Paasche teaches wherein at least a portion of

the points are utilized by members for future purchases of products or services through the service provider system (see for example Paasche column 64 lines 22-30).

10. With respect to claim 3, 7, 14, 18, 39 and 43, Paasche teaches the method of claim 1 and 12, respectively (as described above). Paasche teaches wherein at least a portion of the points are utilized by members for application to a health savings account or a similarly approved account (see for example Paasche column 65 lines 17-29).

11. With respect to claim 5, 9, 16, 20, 41, and 49 Paasche teaches the method of claim 1 and 12, respectively (as described above). Paasche teaches wherein at least a portion of the points are utilized by members to offset costs associated with a health savings account or a similarly approved account (see for example Paasche column 67 lines 1-14).

12. With respect to claim 23, 24, 32 and 37, Paasche teaches a method of selling a health related product or service via the Internet, comprising:
providing a service provider system that includes a web server, the service provider system having members that purchase health related products and services through the service provider system (see for example Paasche column 25 lines 2-30);
enrolling applicants in the service provider system as members (see for example Paasche column 2 lines 23-42); assigning to a member a member identifier member and a debit or credit card (see for example column 49 lines 46-50);

receiving a product or service request message for a desired product or service from a member through a customer interface, the product or service request message including a product or service identifier (see for example Paasche column 2 lines 63-67 and column 3 lines 1-16 and Fig 1); transmitting by the service provider system a request for the desired product or service request to a supplier of the desired product or service (see for example Paasche column 9 lines 30-42); and recording within a computer memory points awarded to a member for purchases (1) made by the member itself through the service provider system (see for example Paasche column 66 lines 26-42 and Fig. 20), (11) made by members who were referred to the service provider system by the member (see for example Paasche column 29 lines 65-66), and (111) made by members who were referred to the service provider system by members in (11), wherein the service provider system pays at least a portion of federal tax due for the points awarded (see for example Paasche column 31 lines 65-67 and column 32 lines 1-4 and Fig. 2).

13. With respect to claim 28, Paasche teaches the method of claim 25 (as described above). Paasche teaches wherein all of the points awarded by the service provider system remain within a community defined by the service provider system (see for example Paasche column 66 lines 27-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4, 6, 8, 10, 15, 17, 19, 21, 27, 40, 42, 44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paasche et al (U.S. 7,359,871) in view of Patricelli et al (U.S. 7,174,302).
15. With respect to claim 4, 6, 8, 10, 15, 17, 19, 21, 27, 40, 42, 44 and 46 teaches the method of claim 3 and 14 (as described above). Paasche does not teach wherein at least a portion of the points utilized by members for application to the health savings account or a similarly approved account are not treated as taxable income for federal income tax purposes at they time they are awarded or used. Patricelli teaches a designating a portion of his or her compensation into an FSA on a tax-free basis (see for example Patricelli column 1 lines 35-37). It would have been obvious to one of ordinary skill in the art at the time of invention not to tax the account to give incentives to the members.
16. Claims 11, 22 and 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Paasche et al (U.S. 7,359,871) in view of Heimermann et al (U.S. 7,110,976).

17. With respect to claim 11, 22 and 26, Paasche teaches the method of claim 1 and 12 (as described above). Paasche does not teach further comprising: aggregating the purchasing power of the members in the service provide system. Heimermann teaches aggregating the purchasing power of the members in the service provide system (see for example Heimermann column 8 lines 30-33). It would have been obvious to combine both features to get discounts and other special offers for purchasing a larger amount.

18. Claims 30, 31, 35, 36, 47, 51, 52, 52, 54, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paasche et al (U.S. 7,359,871) in view of Shurling (U.S. 6,424,951).

With respect to claims 30, 31, 35 and 36, Paasche teaches the method of claim 25 and 32 (as described above). Paasche does not teach wherein the number of points awarded to a member of purchases made under (11) or (111) is capped in number or value. Shurling teaches wherein the number of points awarded to a member of purchases made under (11) or (111) is capped in number or value (see for example Shurling column 12 lines 1-8). It would have been obvious to one of ordinary skill in the art at the time of invention to put a cap on the rewards to avoid financial loss for the company.

19. With respect to claim 47 Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the points are transferable

only by a member to an exempt organization for use in fulfilling its exempt purpose (see for example column 67 lines 56-62).

20. With respect to claim 51, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the points can only be used as a discount on future purchases of products or services through the service provider system by the member who earned them (see for example Paasche column 64 lines 22-30).

21. With respect to claim 52, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the products are selected from vitamins or nutritional supplements, energy/protein bars, health food products, weight loss products, non-prescription drugs, prescription drugs, contact lenses and associated supplies, dermatology/skin care products, oral care products, fitness products, fitness clubs, health books, health and fitness magazines, health insurance, wellness insurance, disability insurance, dental insurance, pet insurance, allergy and asthma products, diabetes products addiction treatment and rehabilitation treatment centers, athletic clothing and gear, therapeutic and chiropractic products, pet care and medication products, and exercise equipment (see for example column 58 lines 4-13).

22. With respect to claim 53 and 54, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the services are health

savings accounts or a similarly approved account (see for example Paasche column 65 lines 17-29).

23. With respect to claim 55 Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche does not teach wherein the services are banking services. Paasche teaches the exemplary services available are rental cares, hotels, eye products and insurance (see for example Paasche column 65 lines 17-29). A predictable result would be for the services to be any type of service (banking, insurance etc.) to cater the needs of members.

24. With respect to claim 56, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the services are insurance services (see for example Paasche column 65 lines 17-29).

25. With respect to claims 57, 58, 59, 60 and 61, Paasche in view of Shurling teaches the limitations of claim 36. Paasche in view of Shurling does not teach getting the services from a medical information website, physician guides, hospital ratings, preventative care and wellness services, nurse hotline and health network charitable foundation services. Paasche teaches the products may include catalog items as well as a link to the marketing company-sponsored Internet Service Provider (see for example Paasche column 60 lines 31-36). A predictable result would have been to use the services available from any database or network (e.g. medical information website,

physician guides, hospital ratings, preventative care and wellness services, nurse hotline and health network charitable foundation services) to give members more options.

26. With respect to claim 62, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches further comprising: enrolling each member in the service provider system; and assigning to a member a member identifier (see for example Paasche column 2 lines 23-42);

27. With respect to claim 63, Paasche in view of Shurling teaches the method of claim 62 (as described above). Paasche teaches further comprising: assigning to a member a debit or credit card (see for example Paasche column 49 lines 46-50).

28. With respect to Claim 64 Paasche in view of Shurling teaches the method of claim 62 (as described above). Paasche teaches wherein the product or service request message is accompanied with the member number identifier as well as the member number identifiers of the members in (11) and (111) of claim 16 (see for example Paasche column 47 lines 54-65, column 31 lines 65-67 and column 32 lines 1-4 and Fig. 2).

29. With respect to claim 65, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche does not teach wherein the service provider

system enables a member to transfer points to a charitable fund. Paasche teaches transfer of point values from one IBO to another (see for example Paasche column 67 lines 56-62). A predictable result would have been to be able to transfer points to desired account (e.g. charitable funds, police stations, hospital funds, homeless shelters) to help the community and in doing so getting a tax write off.

30. With respect to claim 66, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the service provider system enables a member to transfer points to another member (see for example Paasche column 67 lines 56-62).

31. With respect to claim 67, Paasche in view of Shurling teaches the method of claim 36 (as described above). Paasche teaches wherein the service provider system includes a browsable catalog of products and services (see for example Paasche column 40 lines 2-9).

32. With respect to claim 68, Paasche in view of Shurling teaches the method of claim 36(as described above). Paasche teaches further comprising: assigning to a member a debit or credit card a debit or credit cards for selected members for purchases through the service provider system (see for example Paasche column 49 lines 46-50).

33. With respect to claim 69, Paasche in view of Shurling teaches the method of claim 68 (as described above). Paasche teaches wherein the service provider system receives a portion of a debit or credit card fee associated with using the debit or credit card for purchases made through the service provider system (see for example Paasche column 61 lines 9-31)

34. Claims 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paasche et al (U.S. 7,359,871) in view of Martinez et al (6,119,229).

With respect to claim 48, Paasche teaches the method of claim 36 (as described above). Paasche does not teach wherein at least a portion of the points can not be converted to cash or a cash equivalent. Martinez teaches wherein at least a portion of the points can not be converted to cash or a cash equivalent (see for example Martinez column 25 lines 40-47). It would have been obvious to one of ordinary skill in the art at the time of invention to give no cash value to reward points to keep the members from using the accumulated points to buy products that are not sold by the service provider system.

35. Claims 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paasche et al (U.S. 7,359,871) in view of Bednarek (U.S. 6,965,868).

With respect to claim 49, Paasche teaches the method of claim 36 (as claimed above). Paasche does not teach wherein the points have a limited life. Bednarek teaches wherein the points have a limited life (see for example Bednarek column 17 lines 61-

67). It would have been obvious to one of ordinary skill to have expiration dates on the points to encourage the members to use it and motivate them to purchase more items in the long run.

36. With respect to claim 50, Paasche in view of Bednarek teaches the method of claim 36 (as described above). Paasche in view of Bednarek does not teach wherein the points have a life of no more than months. Bednarek teaches wherein the points have an expiration date (see for example Bednarek column 17 lines 61-67). A predictable result would be to give different expiration dates to the reward points (e.g. 1 year, 24 months, 16 months...etc) to motivate members in using the points and encourage members to purchase more items sold by the service provider. KSR International Co. v. Teleflex Inc. et al., 82 USPQ2d 1385 (U.S. 2007)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 7,383,198 teaches a delivery information systems and methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD REYES whose telephone number is (571)270-5212. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6670. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. R./
Examiner, Art Unit 3626

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626